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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85505335
Applicant	The East India Company Holdings Pte. Ltd
Applied for Mark	GUINEA
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Date	03/03/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: The East India Company Holdings Pte. Ltd.)	
)	Trademark Examining Attorney:
Mark: GUINEA)	Karen K. Bush
)	Law Office 108
Serial No.: 85/505335)	
)	
Filing Date: December 29, 2011)	
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Arlington, Virginia 22202-3513		

APPEAL OF REFUSAL TO REGISTER GUINEA

The East India Company Holdings Pte. Ltd (hereinafter “Applicant”) seeks registration of GUINEA for: “Collectible coins and medals made of precious metals and their alloys; precious metals and their alloys; Precious metals and their alloys and goods in precious metals or coated therewith, namely, jewelry and precious stones, tie pins, tiaras, cufflinks, shirt pins, shirt studs and ear studs; jewellery, precious stones; watches; clocks; horological and chronometric instruments,” in class 14. The Trademark Examining Attorney (hereinafter “Examiner”) has refused registration of the specific goods, “collectible coins made of precious metals and their alloys,” on the ground that the applied-for mark merely describes a characteristic of such goods. The refusal to register was made final on July 7, 2015, and a Notice of Appeal from the refusal was timely filed on January 4, 2016.

As discussed in more detailed below, the mark GUINEA is comprised of an obscure foreign term and is not merely descriptive of Applicant’s goods. In addition, the Examiner has not produced sufficient evidence to show that consumers in the United States would understand

the term “guinea” to refer or relate to an historic British coin. Therefore, Applicant respectfully requests that the Examiner’s refusal to register be reversed.

I. STANDARD

A term is considered to be merely descriptive of goods or services “if it **immediately** describes an ingredient, quality, characteristic or feature thereof or if it **directly** conveys information regarding the nature, function, purpose or use of the goods or services.” *In re Pennzoil Prods. Co.*, 20 U.S.P.Q.2d (BNA) 1753, 1755 (T.T.A.B. 1991) (emphasis added).

Obscure terms from English or another language are not descriptive, even if a small fraction of Americans may recognize that they potentially have some descriptive meaning. *See Le Blume Imp. Co., Inc. v. Coty*, 293 F. 344, 354 (2d Cir. 1923) (holding that ORIGAN was not descriptive for perfume because “[i]t is in no sense a word of common speech in English,” despite the fact that “origan” has an obscure meaning as another name for the herb marjoram); *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 3 U.S.P.Q.2d (BNA) 1450, 1452, 824 F.2d 957, 959 (Fed. Cir. 1987) (“In dealing with all of these questions of the public’s response to word symbols, we are dealing with the supposed reactions of a segment of the American public . . . [not] with computer operators checking out the meaning of strange words on NEXIS.”). Rather, obscure terms are distinctive and function as a trademark. *See Gen. Cigar Co., Inc. v. G.D.M. Inc.*, 45 U.S.P.Q.2d (BNA) 1481, 1491, 988 F. Supp. 647, 660 (S.D.N.Y. 1997) (“A word which is not in general or common use, and is unintelligible and non-descriptive to the general public, although it may be known to linguists and scientists, may be properly regarded as arbitrary and fanciful and capable of being used as a trademark”); *Le Blume*, 293 F. at 358–59 (“a word which has become obsolete, which is unintelligible and nondescriptive to the general public, may be regarded as arbitrary and fanciful, and entitled to be used as a trade-mark”).

II. DISCUSSION

A. The Term “Guinea” Is an Obscure Foreign Term and Not Descriptive

The term “guinea” is an obscure foreign term and therefore not descriptive of Applicant’s goods. The Examiner contends that the term “guinea” is not obscure and that consumers would perceive the applied-for mark as describing a feature of applicant’s goods, that is containing or incorporating guineas.

To support the descriptiveness refusal, the Examiner in the first Office Action cited eleven websites that feature jewelry, watches, clocks, and money clips incorporating commemorative coins and coins recovered from sunken ships and lost treasures to support the descriptiveness refusal. However, none of the cited websites show any items made from guineas. The Examiner also relied on a dictionary definition from the Yahoo! Education website, which defines the guinea as “a gold coin issued in England from 1663 to 1813 and worth one pound and one shilling.” In the Final Office Action, the Examiner cites four websites that discuss the history of the guinea, Wikipedia.org, royalmint.com (a U.K. website), eBay.co.uk (the U.K. eBay website), and 24-carat.co.uk (a U.K. website).

However, the evidence presented by the Examiner only supports the applicant’s contention that the allegedly descriptive meaning of “guinea” is extremely obscure. The evidence shows that the guinea is an historic British coin that was used in connection with a currency that was circulated in England from 1663 to 1813. It has been over 200 years since such coins circulated in England, and the guinea coinage was **never** circulated in the United States. Given its historical obscurity, prospective American purchasers have no reason to associate the term “guinea” with any descriptive meaning; thus, “GUINEA” functions as a trademark and is distinctive. *See* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:33 (4th ed. 2015) (“The fact that only lexicographers or devotees of

antiquity may recognize the descriptive feature of a mark is irrelevant to the critical enquiry of the effect of the term upon a substantial segment of prospective purchasers”).

This conclusion is further supported by the fact that the GUINEA mark has been found to be distinctive in the European Union. *See* Ex. A, Community Trade Mark online database record for GUINEA, CTM No. 010486587. The term “guinea” is far more obscure in the United States than it is in the United Kingdom, which has a closer historical nexus to the historic currency. Therefore, if GUINEA can function as a distinctive trademark in the United Kingdom, it should be considered a distinctive mark in the United States as well.

For at least the reasons stated above, “guinea” is an obscure foreign term and is not descriptive of Applicant’s goods. Accordingly, the refusal to register should be reversed.

B. The Examiner Has Not Produced Sufficient Evidence to Show that American Consumers Would Understand the Term “Guinea” to Refer or Relate to a Historic British Coin

The Examiner has not demonstrated that the consuming public in the United States would immediately understand the mark GUINEA to refer or relate to a coin that was circulated in England from 1663 to 1813. The Trademark Manual of Examining Procedure (“TMEP”) precludes the Examining Attorney from finding that a mark is merely descriptive without sufficient evidence to support the conclusion. *See* TMEP § 1209.02 (Oct. 2015) (if the examining attorney refuses registration on the ground that the mark is merely descriptive, “he or she must support the refusal with appropriate evidence”).

Here, the evidence submitted by the Examiner is insufficient to prove that the term “guinea” is immediately understood by American consumers to designate or relate to a coin previously circulated in England. Rather, the evidence submitted shows only that the guinea was a coin in circulation in England over 200 years ago, that the guinea coin never circulated in the United States, and that various items (watches, jewelry, money clips) can be made from ancient

coins. There are no examples showing that American consumer will immediately associate the obscure term “guinea” with any descriptive meaning. In fact, the Examiner relies almost exclusively on foreign websites, rather than U.S. websites, to explain what the term “guinea” means, which further supports that the term is obscure and not relevant to American consumers.

In addition, the merely descriptive standard refers to what consumers generally know about the descriptive meaning of a word, not what they can learn searching Wikipedia or online references. See *In re Namibia Breweries Ltd.*, Appeal No. 77/761,812, Board’s Decision at 16 (“[T]he fact that information about a place is generally available if one were to search for it on the Internet does not in itself make the place generally known”); *In re Societe Generale*, 824 F.2d at 959 (noting that the relevant American consuming public are not “computer operators checking out the meaning of strange words on NEXIS”). Given the vast amount of information available on the internet, one can find information about anything. Thus, the relevant inquiry is not whether information about the guinea exists, but whether the American consumer would have any reason to know the meaning of such an obscure term. See *In re Namibia Breweries Ltd.*, Appeal No. 77/761,812 Board’s Decision at 16 & n. 27 (noting that websites that are likely to have information about essentially anything at all do not establish what meanings of a word relevant purchasers are likely to know or be exposed too).

The evidence cited by the Examiner does not demonstrate that the term “guinea” is immediately understood by American consumers to refer or relate to a coin that circulated in England over 200 years ago. Therefore, the mark GUINEA is distinctive, and the refusal to register should be reversed. *In re Smart Belt Corp. of America*, 2002 T.T.A.B. LEXIS 213 at 4-5 (T.T.A.B. 2002).

III. CONCLUSION

For at least the foregoing reasons, Applicant respectfully requests that the Examiner's refusal to register be reversed, and the application passed to publication.

Dated: March 3, 2016

Respectfully submitted,

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EXHIBIT A

You are here: [Home](#) > [Quality plus](#) > Databases

CTM-ONLINE - Detailed trade mark information



Trade mark name : GUINEA
Trade mark No : 010486587
Trade mark basis: CTM
Date of receipt : 12/12/2011
Number of results: 1 of 13

[Request an inspection](#)

[Certified copy of the Application form](#)



Filing date: 12/12/2011
Nice Classification: 14, 35, 36 ([⇒ Nice classification](#))
Trade mark: Individual
Type of mark: Word
Acquired distinctiveness: No
Applicant's reference: THE003/0059
Status of trade mark: [Application published](#) ([⇒ Glossary](#))
 ([⇒ Publication A1 or Publication A2](#))
 ([⇒ History of statuses](#))
Filing language: English
Second language: French
National search requested: No

Graphic representation

No entry for application number: 010486587.

List of goods and services

Nice Classification: 14
List of goods and services Medals made of precious metals and their alloys; precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; watches; clocks; horological and chronometric instruments.

Nice Classification: 35
List of goods and services Advertising; business management; business administration; office functions; storage, analysis, retrieval and provision of information relating to the trading of gold and precious metals; providing the administration for trading in gold and other precious metals; retail services connected with the purchase and sale of precious metals, coins, bullion, gold, silver and precious stones.

Nice Classification: 36
List of goods and services Insurance; financial affairs; monetary affairs; real estate affairs; financial services; real estate agency services; financial transactions relating to gold, silver and other precious metals; insurance and loans in relation to gold, silver and other precious metals.

Description

Description of the mark: -

Owner

Name: The East India Company Holdings Pte. Ltd
ID No: 443546
Natural or legal person: Legal entity
Address: 150 Orchard Road, Orchard Plaza
Post code: 238841
Country: Singapore

Town: Singapore
Country: SINGAPORE
Correspondence address: The East India Company Holdings Pte. Ltd 150 Orchard Road, Orchard Plaza Singapore 238841 SINGAPUR

Representative

Name: JOSHI & WELCH LIMITED
ID No: 36070
Type: 4 - Association
Address: 45 Moorfields
Post code: EC2Y 9AE
Town: London
Country: UNITED KINGDOM
Correspondence address: JOSHI & WELCH LIMITED 45 Moorfields London EC2Y 9AE REINO UNIDO
Telephone: 00 44-2034902001
Fax: 00 44-2034902002
E-mail: info.london@joshiwelch.com

Seniority

No entry for application number: 010486587.

Exhibition priority

No entry for application number: 010486587

Priority

No entry for application number: 010486587.

International Registration Transformation

No entry for application number: 010486587.

Publication

Bulletin no.: [2012/091](#)
Date of publication: 16/05/2012
Part: A.1
Bulletin no.: [2012/007](#)
Date of publication: 11/01/2012
Part: C.2.1

Opposition

No entry for application number: 010486587.

Cancellation

No entry for application number: 010486587

Appeals

No entry for application number: 010486587.

Recordals

Title: Representative
Sub-title: Change of name and professional address
ID No: 006193745
Bulletin no.: [2012/007](#)
Date of publication: 11/01/2012
Part: C.2.1

Renewals

No entry for application number: 010486587.

